



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,917	07/17/2000	Nancy M Greene	476-1861	1520

23644 7590 11/13/2006
BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

EXAMINER

HSU, ALPUS

ART UNIT PAPER NUMBER

2616

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,917

Applicant(s)

GREENE ET AL.

Examiner

Alpus H. Hsu

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

Art Unit: 2616

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "12" and "13" have both been used to designate "N-ISDN", which does not correspond to the specification disclosure, wherein the reference character "12" was used to designate "LAN". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. For proper consideration by the examiner, the applicant is requested to file an information disclosure statement complying with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the

Art Unit: 2616

information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 4-6, it is confusing for reciting "a distributed gateway providing an interface between said circuit switched network and said service provider and packet networks" since it requires **two gateways**, one between the circuit switched network and the service provider network, and one between the circuit switched network and packet network according to Figure 1 and specification disclosure. Lines 6-7, the recitation of "whereby to effect access of said packet network to services provided by said service provider network" is rejected as functional language since there is no data structure supporting the claimed function.

In claim 6, lines 1-2, "said shared set top unit" lacks antecedent basis; line 3, the recitation of "whereby to set up calls to said service provider network" is rejected as functional language since there is no data structure supporting the claimed function.

In claim 7, lines 6-7, it is confusing for reciting "a distributed gateway providing an interface between said circuit switched network and said service provider and packet networks" since it requires **two gateways**, one between the circuit switched network and the service provider network, and one between the circuit switched network and packet network according to Figure 1 and specification disclosure. Lines 8-9, the recitation of "whereby to effect access

Art Unit: 2616

of said packet network to services provided by said service provider network” is rejected as functional language since there is no data structure supporting the claimed function.

In claim 8, lines 6-7, the recitation of “whereby to effect access of said packet network to services provided by said service provider network” is rejected as functional language since there is no data structure supporting the claimed function.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by TEMPLETON et al. in U.S. Patent No. 5,692,126, hereinafter referred to as TEMPLETON.

Referring to claim 1, TEMPLETON discloses a communications network configuration comprising a packet network (72) to which a plurality of terminals (44, 46) are connected, a service provider network (42), a circuit switched network (66) provided intermediate said packet and service provider networks, and a pair of distributed gateways (62, 68) providing an interface between said circuit switched network and said service provider network, and an interface between said circuit switched network and said packet network, thereby to effect access of said packet network to services provided by said service provider network (see col. 2, line 55 to col. 3, line 3, col. 3, lines 15-39, col. 4, line 7 to col. 6, line 56, col. 7, line 60 to col. 8, line 20).

Referring to claim 2, TEMPLETON discloses that the circuit switched network comprises an asynchronous transfer mode (ATM) network (see col. 3, lines 4-9).

Referring to claim 7, TEMPLETON discloses a method for transmitting service traffic in a communications network comprising a packet network to which a plurality of terminals are connected, a service provider network arranged to provide service traffic, a circuit switched network provided intermediate said packet and service provider networks, the method including transmitting said service traffic via a pair of distributed gateways providing an interface between said circuit switched network and said service provider network, and an interface between said circuit switched network and said packet network, thereby to effect access of said packet network to services provided by said service provider network (see col. 2, line 55 to col. 3, line 3, col. 3, lines 15-39, col. 4, line 7 to col. 6, line 56, col. 7, line 60 to col. 8, line 20).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2616

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over TEMPLETON in view of BALDWIN et al. in U.S. Patent No. 5,633,868, hereinafter referred to as BALDWIN.

Referring to claim 3, TEMPLETON differs from the claim, in that, it does not disclose the feature of having ATM network carrying traffic in AAL-2 minicells, which is well known in the art and commonly used in ATM networking environment. BALDWIN, for example, from the similar field of endeavor, teaches the transmission of ATM cells complying with AAL-2 protocol (see col. 8, line 36 to col. 9, line 3), which can be easily adopted by one of ordinary skill in the art into the system and method in TEMPLETON, to provide data transmission in specific ATM cell format as desired to fulfill the system specification requirement.

10. Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over TEMPLETON in view of BALDWIN, as applied to claim 3 above, and further in view of HUMPLEMAN in U.S. Patent No. 5,579,308, hereinafter referred to as HUMPLEMAN.

Referring to claim 4, the system from TEMPLETON in view of BALDWIN differs from the claim, in that, it does not disclose a shared set top unit for terminals, which is also well known in the art and commonly used in multimedia networking industry. HUMPLEMAN, for example, from the similar field of endeavor, teaches the uses of conventional set top unit (see col. 1, lines 40-54), which can be easily adopted by one of ordinary skill in the art into the system from TEMPLETON in view of BALDWIN, to provide connections between subscribers and external network and data provider to fulfill the system specification requirement.

Referring to claim 5, TEMPLETON discloses a telephony service manager (58) for establishing calls between said terminals and said service provider network.

Art Unit: 2616

11. Claim 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over TEMPLETON in view of HUMPLEMAN.

Referring to claim 8, TEMPLETON differs from the claim, in that, it does not disclose a shared set top unit for terminals, which is also well known in the art and commonly used in multimedia networking industry. HUMPLEMAN, for example, from the similar field of endeavor, teaches the uses of conventional set top unit (see col. 1, lines 40-54), which can be easily adopted by one of ordinary skill in the art into the system in TEMPLETON, to provide connections between subscribers and external network and data provider to fulfill the system specification requirement.

Referring to claim 9, TEMPLETON discloses a telephony service manager (58) for establishing calls between said terminals and said service provider network.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alexander, Jr. et al., Frick et al., Bartholomew et al., and Civanlar et al. are cited to show the common feature of communication network configuration utilizing gateways/routers/bridges for interconnecting different networks with terminals therein similar to the claimed invention.

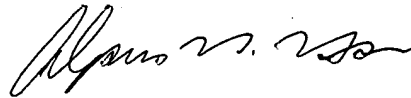
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHH



Alpus H. Hsu
Primary Examiner
Art Unit 2616